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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,180	02/25/2004	Thomas Birkhoelzer	32860-000704/US	3381

30593 7590 10/04/2007
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EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,180

Applicant(s)

BIRKHOELZER ET AL.

Examiner

April Y. Shan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 06 July 2007, has been received, entered into the record, and respectfully and fully considered.
2. As a result of the amendment, claims 1, 8, 22 and 31 have been amended. Claims 1-32 are now presented for examination.
3. Any objections/rejections not repeated below for record are withdrawn due to Applicant's amendment.
4. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below. It is noted that some of the Applicant's arguments are directed towards limitations newly added via amendments.

Information Disclosure Statement

5. The information disclosure statement filed 9 April 2007 fails to comply with 37 CFR 1.98(a)(3) because German Office action does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Priority

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6. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. Germany 10307996.3, filed on 25 February 2003.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e). Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Specification

7. The amendment filed 6 July 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In the par. [0020] of the disclosure, the Applicant added "In step 13, the user may be assigned to a user group". However, the original disclosure discloses in par. [0011], "...association with the user group". "Assign user to user group" and "association with the user group" are different.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the new claim limitation assigning a data key to the user must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Further, in the replacement figure 1, the Applicant disclose in step 13, "Assign user to user group" and the examiner cannot find support in the original disclosure. The original disclosure discloses in par. [0011], "...association with the user group". "Assign user to user group" and "association with the user group" are different.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 1, 8 and 22, the Applicant added the new claim limitation of "assigning a data key to the user". The examiner respectfully and carefully reviewed the Applicant's original disclosure and did not find support in the original disclosure. In par. [0011], the Applicant discloses "... people... who have joint use of encrypted data not being assigned user-specific data key for accessing the data....The data key is automatically assigned but is not communicated to the user, i.e. the users receive no knowledge of the actual nature of the data key. Accordingly, they neither need to remember the data key nor are they able to communicate it....". Additionally, in par. [0012], the Applicant discloses "... Instead, they are simply no longer assigned a valid data key if they attempt to access data". It is very clear that both the new claim

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limitations and Applicant's argument on pages 12-14 are contradicted with Applicant's original disclosure.

In order to further exam on the merits of the claims, "assigning a data key to the user" is interpreted as "the data key is automatically assigned but is not communicated to the user and the users are no longer assigned a valid data key"

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 103

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl et al. (U.S. Patent No. 6,031,910).

As per claims 1 and 8, Deindl et al. discloses a method/facility for at least one of encrypting and decrypting data, comprising: performing a security check to ascertain an identity of a user ("authorizing a user assigned to a user group by means of an identification feature" – e.g. col. 6, lines 22 – 23 and e.g. col. 6, lines 33-43. Please note authorizing a user corresponds to Applicant's performing a security check); assigning a data key, unviewable by the user, on the basis of a result of the security check ("generating one or more cryptographic keys in the chip card for use by a computer...encrypting at least one of cryptographic keys in the chip card with a second cryptographic key..." – e.g. col. 6, lines, 23-32. Please note the one or more cryptographic keys reside on the chip card and encrypted. Therefore, the keys are unviewable by the user).

Deindl et al. does not expressly disclose assigning a data key to the user and wherein the same data key is assignable to a plurality of users.

However, Deindl et al. discloses in col. 7, lines 57-63, "...The user card contains a set of group keys which the system operator defines....The group key varies according to his job in the health service and in accordance with medical specialty".

It would have been obvious to a person with ordinary skill in the art at the time of the invention, a group key is the same data key assignable to a plurality of users. In the Deindl et al. reference, a doctor with the same medical specialty shares a same group key and a data key assigned to the user since the system operator defines a set of group keys in the user card disclosed in the Deindl et al. reference.

The motivation of doing so would have been that the doctor with the same medical specialty can share the same group key and also provides time-saving to the system operator when defining keys for a group of doctors with the same medical specialty.

As per claims 2 and 9, Deindl et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the security check involves checking biometric data of the user (e.g. col. 6, lines 33-43).

As per claims 3 and 10, Deindl et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the security check involves checking a user-specific at least one of electronic and mechanical key ("In reading a file the doctor must be in possession of a user card 310. The user card 310 legitimizes the doctor as an authorized doctor in a particular specialty – e.g. col. 4, lines 53 –55 and col. 7, lines 57-63. Please note a doctor's user card corresponds to Applicant's a user-specific at least one of electronic and mechanical key).

As per claims 4-5 and 11-12, Deindl et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the data key is ascertained by comparing the data obtained in the security check with content of a data key memory and wherein the data obtained in the security check are compared with the content of the data key memory using a data telecommunication device (e.g. col. 4, lines 26-36 and col. 4, lines 53-67).

As per claim 6, Deindl et al. discloses a method as applied above in claim 1. Deindl et al. further discloses wherein a plurality of data keys are simultaneously assignable to one user (e.g. col. 6, lines 23-25).

As per claims 7 and 13, Deindl et al. discloses a method/facility as applied above in claims 1 and 8. Deindl et al. further discloses wherein the data are medically relevant, wherein the users include personnel at a medical facility, and wherein common user groups are assigned the same data key (e.g. col. 7, lines 57-63).

As per claim 14, Deindl et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Deindl et al. discloses the claimed information stored on a storage medium for carrying out the method of steps.

As per claim 32, Deindl et al. discloses a method as applied above in claim 1. Deindl et al. further discloses wherein users associated with a common user group are assigned the same data key (e.g. col. 7, lines 57-63 and see the above rationale in rejecting claim 1 above).

As per claims 15 and 20, they are rejected using the same rationale as rejecting claim 3 above.

As per claims 16-17, they are rejected using the same rationale as rejecting claim 4 above.

As per claims 18-19, they are rejected using the same rationale as rejecting claim 5 above.

As per claim 21, it is rejected using the same rationale as rejecting claim 11 above.

As per claims 22 and 31, they are rejected using the same rationale as rejecting claims 1 and 8 above.

As per claim 23, Deindl et al. discloses the claimed method of steps as applied above in claim 22. Therefore, Deindl et al. discloses the claimed information stored on a storage medium for carrying out the method of steps.

As per claim 24, it is rejected using the same rationale as rejecting claim 2 above.

As per claim 25, it is rejected using the same rationale as rejecting claim 3 above.

As per claim 26, it is rejected using the same rationale as rejecting claim 4 above.

As per claim 27, it is rejected using the same rationale as rejecting claim 5 above.

As per claim 28, it is rejected using the same rationale as rejecting claim 6 above.

As per claim 29, it is rejected using the same rationale as rejecting claim 7 above.

As per claim 30, it is rejected using the same rationale as rejecting claim 32 above.

Response to Arguments

14. Applicant's arguments filed 6 July 2007 have been respectfully and fully considered but they are not persuasive.

15. The Applicant argues on pages 12-13, "...Deindl fails to disclose any connection between or association between cryptographic keys and users, let alone, assigning a cryptographic key to user...no cryptographic keys are assigned...", the examiner respectfully disagree.

The examiner respectfully points out in claims 1-32 of the current application, "cryptographic key(s)" are never being recited, instead of "data key(s)" are being recited. Cryptographic keys and data keys are different. Data key can be reasonably interpreted as any type of key contains data. Further, "any connection between or association..." argument has been traversed in the above 112 1st rejection and 103 rejection above. Furthermore, the applicant is respectfully reminded that the recitation "...for at least one of encrypting and decrypting data" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a

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structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

16. The Applicant argues on page 13-14, "Claims 8, 22 and 31...regard to claim 1. Claims 2-7...are patentable over Deindl at least by virtue of their dependency from independent claims 1, 8, 22 and 31", the examiner respectfully disagree.

Since the arguments for the independent claim 1 is traversed and claims 8, 22 and 31 are similar claims, they are also not allowable. Further, the dependent claims are also are not allowable.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

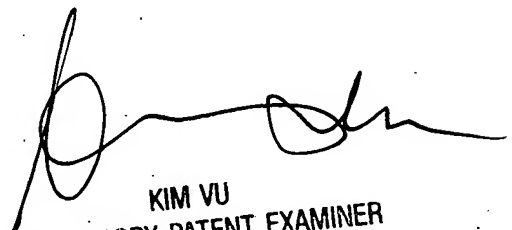
Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



26 September 2007

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